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| EXAMINER |
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VO, LILIAN

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| ART UNIT | PAPER NUMBER |
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2195

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/992,603

Applicant(s)

GOLDICK, JONATHAN S.

Examiner

Lilian Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 – 26 are pending.

Claim Objections

2. Claims 8, 9 and 18 are objected to because their formats are improper. They are claiming the computer program product but depending on the method claims. Furthermore, claim 9 depends on claim 5, which depends on claim 4. The Office is not sure whether they are independent claims, which claim the computer program product or the dependent claims of the method claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. Claims 8, 9, 10 and 18 – 26 are rejected under 35 U.S.C. 101 because they are directed to non-statutory subject matter.
4. Claims 8, 9 and 18, which claim both an apparatus and the method steps of using the apparatus should also be rejected under 35 U.S.C. 101, *Ex parte Lyell*, 17 USPQ 2d 1548 (Bd. Pat. App. & Inter. 1990), based on the theory that the claim is directed to neither a “process” nor a “product” but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

Correction is required.

5. **Claim 10** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As written, the invention does not need to be practiced in the useful or technological arts and therefore are not limited to practical applications in the technological arts. Examiner finds that the limitations “a locked resource”, is not tangibly embodied and merely represents an abstract idea, thus making the claims directed to nonfunctional descriptive material.

6. **Claims 19 - 26** is directed to non-statutory subject matter and is rejected under 35 U.S.C. 101 because it is not tangibly embodied in a manner so as to be executable and the system itself is not including/defining any specific hardware.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 7 – 10 and 18 - 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Exparte Lyell*, 17 IJSPQ 2d

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1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C.

112, second paragraph.

In **claims 8, 9 and 18**, it is unclear whether a program product or a program code or a process of managing a locked resource in a distributed environment is claimed.

Appropriate correction is required.

10. Regarding **claim 10**, the phrase "may comprises" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

11. The following terms lack of antecedent basis:

- a. "the retry", in **claim 1**.
- b. "the type of request", in **claim 7**.
- c. "the expected lifetime", in **claims 19 and 20**.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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13. Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Vahalia et al. (US 6,389,420, hereinafter Vahalia).

14. Regarding **claim 10**, Vahalia discloses a computer-readable medium having stored thereon a locked resource, wherein the locked resource (col. 5, lines 44 – 61, col. 12, lines 31 – 58) comprises:

a resource object data section for storing actual object data (figs 1 – 2); and

a lock object, wherein the lock object may comprise an expected lifetime property (col. 8, lines 1 – 5, col. 9, lines 13 – 22).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1, 6 – 8, 11, 12 and 14 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vahalia et al. (US 6,389,420, hereinafter Vahalia).

17. Regarding **claim 1**, Vahalia discloses a method of managing a locked resource in a distributed environment, the method comprising:

receiving a request to access the resource, wherein the request originates from a requesting client computer system (fig. 8: 81);

determining whether the resource has a conflicting lock (fig. 8: 86);

if the resource has a conflicting lock, returning lock information to the requesting client computer system (fig. 8: 86, 90 and 91);

if the resource does not have a conflicting lock, performing the requested access (fig. 8: 87).

With respect to the limitation of returning the lock information to the requesting client so that the retry strategy of the requesting client may be modified, Vahalia discloses if there is an existing incompatible lock, then the file manager puts the client on a wait list for the file to be accesses and returns a lock denied message to the client (col. 11, lines 17 – 22). It would have been obvious for one of an ordinary skill in the art, at the time the invention was made, that the requesting client might modify the retry strategy while waiting after being informed of the conflicted lock so that the resources can be accessed as soon as they are available.

18. Regarding **claim 6**, Vahalia discloses the lock property relates to the sharing property values of the lock (col. 8, lines 47 – 66, col. 10, lines 59 – 62, col. 16, lines 45 – 55).

19. Regarding **claim 7**, Vahalia discloses the search strategy relates to the type of the request (col. 8, lines 47 – 66, col. 9, lines 19 – 23, col. 16, lines 45 – 65)

20. **Claims 8 and 11** are rejected on the same ground as stated in claim 1 above.

21. Regarding **claim 12**, Vahalia discloses the request for access to the resource further comprises a request to block the resource (col. 10, line 56 – col. 11, line 2, col. 16, lines 45 – 55)).

22. Regarding **claim 14**, Vahalia discloses a method of unlocking a locked resource in a distributed environment, the locked resource having a lock object associated with a lock owner, the method comprising:

receiving a request to access the locked resource, wherein the request originates from a requesting client computer system other than the lock owner and wherein the request comprises a request to break the lock object (fig. 2, fig. 8: 81, 84, 85, 86);

determining whether the requesting client computer system is cleared to break the lock object (fig. 2, fig. 8: 85, 86, 93, col. 11, lines 43 - 65); and

removing the lock object from the resource if the requesting client computer system is cleared to break the lock object (fig. 2, fig. 9, 104, col. 16, line 66 – col. 17, line 14).

With respect to the step of identifying the request to break the lock object, Vahalia discloses the request to access a resource specifies the file to be opened for the client and the specified file identifier is used as a search key in the directory in order to determine whether or not the locking information includes one or more current locks upon the file (col. 9, lines 12 – 23). In other words, the resources that are being requested for accessing can be the resources that are being in used by others. Thus, implying that a release of the locked resource is required

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before the accessing request can be fulfilled. Therefore, it is obvious to conclude that the request to access the locked resource implying the request to break to the lock object.

23. Regarding **claim 15**, Vahalia discloses the step of notifying the lock owner that the lock object of the request to break the lock before removing the lock object (fig. 7, col. 10, lines 3 – 40).

24. Regarding **claim 16**, Vahalia discloses the lock object is not removed for a predetermined time following notifying the lock owner of the request of the request to break the lock (figs. 7 - 8: 85, 92, 93, 87, 88 and 89. Col. 10, lines 17 – 40, col. 11, lines 23 – 42: request the lock extension).

25. Regarding **claim 17**, Vahalia discloses the lock object has a timeout property value and the timeout property value is modified to effectively remove the lock object (fig. 3, col. 8, lines 1 – 7)

26. **Claim 18** is rejected on the same ground as stated in claims 14 and 1, above.

27. Claims 2 – 5, 9, 13 and 19 - 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vahalia et al. (US 6,389,420) in view of Applicant's admitted prior art (hereinafter AAPA).

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28. Regarding **claim 2**, Vahalia did not clearly disclose the lock information is related to the expected lifetime of the lock. Nevertheless, AAPA discloses that “lock discovery” provides the expected lifetime of the lock (specification page 3, line 20 – col.4, line 4). It would have been obvious for one of an ordinary skill in the art, at the time the invention was made, to incorporate AAPA’s teaching to Vahalia so that resource can be utilized more affectively as they become available.

29. Regarding **claim 3**, as modified Vahalia discloses lock owner sets the expected lifetime of the lock (Vahalia: col. 8, lines 1 – 5, col. 9, lines 28 – 33, col. 10, lines 36 – 40).

30. Regarding **claim 4**, as modified Vahalia discloses the requesting client computer system modifies a request strategy based on the returned information (AAPA: specification page 3, line 20 – col. 4, line 4).

31. Regarding **claim 5**, as modified Vahalia discloses the search strategy relates to the time period between requests for the resource (AAPA: specification page 3, lines 9 – 10, line 20 – col. 4, line 4).

32. **Claim 9** is rejected on the same ground as stated in claim 5 above.

33. Regarding **claim 13**, as modified Vahalia discloses the request to block the resource is a predetermined header having a time value for defining a time period to block the resource (AAPA: specification page 2, lines 7 – 15, page 3, line 20 – page 4, line 4).

34. Regarding **claim 19**, Vahalia discloses a computer system for managing resource in a distributed environment having a plurality of resources and wherein at least one resource is associated with a lock object, the system comprising:

a receive module for receiving request from a requesting client application program to access at least one resource in the distributed environment (fig. 2, fig. 8: 81, 84, 85 and 86);

a determination module for determining whether the resource has a conflicting lock object associated with the requested resource (fig. 8: 86, col. 11, lines 43 – 65); and

a communication module for returning lock information to the client application program if the resource has a conflicting lock (fig. 8: 86, 90 and 91).

Vahalia did not clearly disclose the lock information lock information returned to the requesting client application program is related to the expected lifetime of the lock.

Nevertheless, AAPA discloses that “lock discovery” provides the expected lifetime of the lock (specification page 3, line 20 – col.4, line 4). It would have been obvious for one of an ordinary skill in the art, at the time the invention was made, to incorporate AAPA’s teaching to Vahalia so that resource can be utilized more affectively as they become available.

35. Regarding **claim 20**, Vahalia discloses an owning client application program owns a lock object for the requested resource; and the owning client application program determines the

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expected lifetime of the lock object (col. 8, lines 1 – 5, col. 9, lines 28 – 33, col. 10, lines 36 – 40).

36. **Claim 21** are rejected on the same ground as stated in claim 4 above.

37. **Claims 22 and 23** are rejected on the same ground as stated in claims 1 and 12 above.

38. Regarding **claim 24**, Vahalia discloses the receive module is adapted to receive a request to break an existing lock object (fig. 2, fig. 8: 81, 84, 85, 86 and fig. 9).

With respect to the concept of the request to break the lock object, Vahalia discloses the request to access a resource specifies the file to be opened for the client and the specified file identifier is used as a search key in the directory in order to determined whether or not the locking information includes one or more current locks upon the file (col. 9, lines 12 – 23). In other words, the resources that are being requested for accessing can be the resources that are being in used by others. Thus, implying that a release of the locked resource is required before the accessing request can be fulfilled. Therefore, it is obvious to conclude that the request to access the locked resource implying the request to break to the lock object.

39. **Claim 25** is rejected on the same ground as stated in claim 24 above.

40. Regarding **claim 26**, Vahalia discloses a system further comprising a determination module that determines whether the requesting client application program is suitably authorized

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and wherein the existing lock object is not removed in response to the request to break the lock object unless the requesting client application program is suitably authorized (fig. 8: 85, 92, 93. Col. 11, lines 22 – 42).

Response to Arguments

41. Applicant's arguments filed 5/20/05 have been fully considered but they are not persuasive for the reason set forth below.

42. Regarding applicant's remarks that "Vahalia does not show the limitation of a lock object including an expected lifetime property" (page 11, 5th paragraph), the examiner disagrees.

Vahalia discloses the lock object including an expected lifetime property in column 8, lines 1 – 5 in which "the timing relationship ... can be enforced by lock expiration timers ... each client allocates a respective lock expiration timer when it requests each lock, and each file manager allocates a respective lock expiration timer for each granted lock."

Furthermore, the Office would like to point out that claim 10 recites the phrase "may comprises an expected lifetime property" which renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. Since the phrase "may comprises..." has been interpreted as may or may not comprise, the reference needs to show only one or the other and it could be that the reference is not required to show such feature at all.

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43. In response to applicant's remarks that the specification stated "the expected lifetime property is used so that the server may notify requesting clients as to the expected lifetime of a lock to improve client-side polling methods" (page 11, 5th paragraph), it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

44. Regarding applicant's remarks that "no reference has shown or disclosed the returning of lock information to the requesting client... upon determining the existence of a conflicting lock..." (page 12, 2nd paragraph), the examiner disagrees. Vahalia clearly discloses if there is an existing incompatible lock, then the file manager puts the client on a wait list for the file to be accesses and returns a lock denied message to the client (col. 11, lines 17 – 22, fig. 8: 86, 90 and 91). Although Vahalia did not clearly disclose that the requesting client may be modified the retry strategy with the returning conflict lock information, it is however obvious for one of an ordinary skill in the art, at the time the invention was made, that the requesting client might modify the retry strategy while waiting after being informed of the conflicted lock so that the resources can be accessed as soon as they are available.

Furthermore, the concept in which the requesting client may be modified the retry strategy with the returning conflict lock information is considered obvious and well known in the art. Thus, support for such concept can be found in applicant's admitted prior art (specification page 3, lines 3 – 15).

Again, the Office would like to point out that claim 1 recites the phrase "may be modified" which renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. Since the phrase "may be modified..." has been interpreted as may or may not modified, the reference needs to show only one or the other and it could be that the reference is not required to show such feature at all.

45. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (page 12, 3rd paragraph – page 13, 2nd paragraph and 4th paragraph), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

46. Regarding applicant's remark that the examiner has failed to provide a citation to a reference for this limitation (page 13, 3rd paragraph), the office action on page 6 clearly stated that claim 11 is rejected on the same ground as stated in claim 1.

With respect to applicant's argument that Vahalia does not teach or suggest blocking the resource for the requesting client (page 13, 3rd paragraph), the examiner disagrees. The prior art discloses that client is put on the wait list for the resource. In other words, when the resource is free/released, the client on the wait list can access the resource accordingly. Thus, when client is

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put on the wait for accessing the resource, it implies that the resource is blocked after it is released to make it available for the requesting clients that are on the wait list.

47. With respect to applicant's remark that the examiner has not provided reference, or a motivation showing the limitation of a request to break a lock object (page 13, 4th paragraph), the examiner disagrees. Vahalia discloses the request to access a resource specifies the file to be opened for the client and the specified file identifier is used as a search key in the directory in order to determine whether or not the locking information includes one or more current locks upon the file (col. 9, lines 12 – 23). In other words, the resources that are being requested for accessing can be the resources that are being in used/blocked by others. Thus, such request is to break a lock on the resource/object. Therefore, a release of the locked resource is required before the accessing request can be fulfilled. It is obvious to conclude that the request to access the locked resource implying the request to break to the lock object.

48. Regarding applicant's remark that the examiner has not provided reference, or a motivation showing the limitation of under what circumstances a lock object could be broken as required by claim 14 (page 13, 4th paragraph), applicant is arguing a feature of the invention not specifically stated in the claim language, which is improper. Claim subject matter, not the specification, is the measure of invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Self*, 213 USPQ 1,5 (CCPA 1982); *In re Priest*, 199 USPQ 11,15 (CCPA 1978).

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49. Applicant's arguments with respect to amended claim 19 (page 14, 1st paragraph) have been considered but are moot in view of the new ground(s) of rejection.

50. With respect to applicant's remark that the examiner has provided no rejections for claims 2 – 5 (page 14, 3rd paragraph), the rejections for claims 2 – 5 were clearly stated in the previous office action on pages 9 – 10.

Conclusion

51. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

52. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lilian Vo whose telephone number is 571-272-3774. The examiner can normally be reached on Monday - Thursday, 7:30am - 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on 571-272-3756. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist at 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lilian Vo
Examiner
Art Unit 2127

lv
7/29/05

MAJID BANANKHAH
PRIMARY EXAMINER
Majid Banankhah